

REMARKS**I. Introduction**

Claims **19, 23, 26, 28-29, 49,** and **53-83** are currently pending in the present application. Claims **19, 49, 53, 64, 72, 76,** and **80-83** are independent.

In the Non-Final Office Action mailed on August 18, 2006 as Part of Paper No./Mail Date 20060814 (hereinafter the "Office Action"), the Examiner imposes a Restriction Requirement. In particular, the Examiner states that the pending claims describe two (2) distinct "inventions":

- I. Claims **19, 23, 26, 28-29, 49,** and **53-81**, drawn to product identity being concealed at the time of offer, classified in class 705, subclass 15.
- II. Claims **82-83**, drawn to an upsell for a purchase at a point-of-sale terminal, classified in class 705, subclass 20.

(Office Action, pg. 2, lines 4-7; emphasis added).

Applicants provisionally elect to prosecute "Invention" I (including claims **19, 23, 26, 28-29, 49,** and **53-81**). This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

II. The Examiner has Failed to Establish a *Prima Facie* Case for Restriction

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

A. Proper Basis for Restriction**1. Generally**

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. MPEP §802.01. The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more

subjects disclosed, that is, they are unconnected in design, operation, or effect". MPEP §802.01. To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". MPEP §808. The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". *Id.* To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". MPEP §808.

2. The Examiner's Case as Set Forth

The Examiner states that the two "inventions" are believed to be distinct because they are sub-combinations disclosed as being usable together in a single combination. Office Action, pg. 2, lines 9-10. The Examiner, however, fails to provide any evidence or support for such a contention. Nowhere does the Examiner describe how the two alleged "inventions" are sub-combinations, nor how or where such alleged sub-combinations are disclosed as being usable together in a single combination (nor, for that matter, what the "single combination" allegedly comprises). Nor is it clear how the alleged "separate utility" of alleged "invention II" is at all related to any pending claim.

Accordingly, the Examiner fails to satisfy the burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions.

B. A *Prima Facie* Case for "Distinct" Restriction has not been Established

No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a

separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." *Id.*

C. The Examiner has Failed to Establish an Undue Burden

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." MPEP §803. Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged Species which would necessitate a separate field of search; (2) the alleged Species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged Species are not related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02. In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had relied upon proper grounds for restriction, restriction would still not be proper in this case.

III. Conclusion

At least for the foregoing reasons, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

IV. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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